

REMARKS

Claim Status:

Claims 1-52 remain pending in the application. Claim 1 is amended by reciting how the title signal is provided (e.g., digital watermarking). Claims 4 and 5 are amended to even better conform to amended claim 1.

Claims 13, 14, 21-25, 30, 37-43 and 49 are amended in an editorial manner by, e.g., removing the term “step” or “steps”. Since other editorial changes also are made, we invite the examiner to inspect the claims for the precious wording of the changes.

Art-based Rejections:

Claims 1-4 and 6-48 are rejected as being anticipated by Tone (US Patent No. 6,640,306). Claims 23 and 49-52 stand rejected as being unpatentable over Tone. Claim 5 stands rejected as being unpatentable over Tone in view of Stefik (US Patent No. 6,233,684).

We respectfully traverse these rejections.

Claim 1 in view of Tone

Claim 1 is amended to recite – in combination with other features – that the title signal is carried with digital watermarking encoded in the digital data. This feature is somewhat akin to the “watermark signal” previously recited in claim 4.

Regarding claim 4, the Office Action cited Tone at Fig. 11 and Col. 11, line 49 – Col. 12, line 6 as teaching extracting a watermark signal from the digital data. *Please see* the Office Action, page 2, paragraph 4.

We have carefully reviewed these passages and do not see any mention of digital watermarking. None.

Claim 1 stands ready for allowance.

Claim 5 in view of Tone and Stefik

Claim 5 recites that the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal.

As discussed above, Tone does not even mention digital watermarking. Claim 4 should be allowed for at least this reason alone.

Moreover, the teachings of Stefik are overstated in the Office Action, page 7, paragraph 29.

The Office Action suggests that the combination recited in claim 5 is disclosed at Col. 1, lines 47-54 and Col. 3, lines 31-34.

We respectfully disagree.

For example, while the Col. 1 passage discusses watermarking, it does not mention anything about “copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal”.

And, while the Col. 3 passage discusses a watermark providing rights associated with a copy of a document, it does not specify “copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal”.

Thus, even if combined as suggested (which we do not concede should be done), the proposed combination does not result in the recited combination.

Claim 5 should be allowed.

Claim 49 in view of Tone

Claim 49 recites – in combination with other features – encrypting a title signal using a private key; detecting, at the player device, the title signal in the data; decrypting the encrypted title signal using the player signal as the private key; determining if the result of the act of decryption results in the title signal; and performing an action based upon the determination.

We respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness.

For example, there is insufficient information provided in paragraph 32, page 8, to show that “one with ordinary skill in the art would understand that comparison/decryption method for authentication in well known and can be interchangeable used based on the designer’s choice.”

We request that the Examiner substantiate this claim so that Applicants have a fair opportunity to respond on the record prior to appeal.

Moreover, we respectfully disagree with the statement “cryptographic authentication utilizing *the same parameter would work equally well* in the method disclosed by Tone.”

How does the Examiner know that cryptographic techniques will work equally well? And, what is meant by “the same parameter”.

We request allowance of this claim or clarification to allow applicants a fair opportunity to respond.

Claims 25, 30 and 43 in view of Tone

Many of the claims enjoy priority to, e.g., parent application no. 08/649,419 (US Patent No. 5,862,260), filed May 16, 1996. Thus, Tone is not a proper prior art reference. Below we provide several tables with examples of how claims 25, 30 and 43 are supported by the parent application. Of course, these examples are not exhaustive as other support is found as well.

Claim 25

| Claim 25 | US Patent No. 5,862,260 |
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| 25. A method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computer, the method comprising: | See, e.g., Col. 27, lines 26-52; Col. 94, lines 28-38; and Col. 41, lines 54 - Col. 42, line 27. |
| providing the digital data having the title signal; | E.g., audio or video including a “universal code”. The universal code may include, e.g., an identifier (e.g., Col. 41, lines 54-Col. 42, line 27), instructions (e.g., Col. 41, lines 54-Col. 42, line 27), flags (see, e.g., Col. 92, lines 4 – 20, Col. 94, lines 28-47), |

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| | etc. |
| detecting, at the personal computer, the title signal in the data; | E.g., detecting the universal code from the audio or video, e.g., Col. 41, lines 54-Col. 42, line 27. See also, e.g., Col. 94, lines 28-38. |
| comparing the title signal to the player signal; and | E.g., applying the daily password to the universal code. See, e.g., Col. 41, lines 54-Col. 42, line 27. |
| performing an action based upon the comparison. | See, e.g., Col. 94, lines 28-38, see also Col. 27, lines 26-52, and Col. 41, lines 54-Col. 42, line 27. |

Claim 30

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| Claim 30 | US Patent No. 5,862,260 |
| 30. A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computer, the method comprising: | See, e.g., Col. 27, lines 26-52; Col. 94, lines 28-38; and Col. 41, lines 54 - Col. 42, line 27. |
| providing the computer readable set of instructions having the title signal; | E.g., a universal code may include, e.g., a instructions, identifiers and passwords (e.g., Col. 41, lines 54-Col. 42, line 27) and etc. |
| detecting the title signal in the computer readable set of instructions; | E.g., detecting the universal code from the audio or video, e.g., Col. 41, lines 54-Col. 42, line 27. See also, e.g., Col. 94, lines 28-38. |
| comparing the title signal to the player signal; and | E.g., applying the daily password to the universal code and/or interpreting the |

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| | universal code system according to the instructions. See, e.g., Col. 41, lines 54-Col. 42, line 27. |
| performing an action based upon the comparison. | See, e.g., Col. 94, lines 28-38, see also Col. 27, lines 26-52, and Col. 41, lines 54-Col. 42, line 27. |

Claim 43

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| 43. A method for utilizing a title signal contained in digital data to be input into a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computer, the method comprising: | See, e.g., Col. 27, lines 26-52; Col. 94, lines 28-38; and Col. 41, lines 54 - Col. 42, line 27. |
| providing the digital data having the title signal; | E.g., audio or video including a "universal code". The universal code may include, e.g., an identifier (e.g., Col. 41, lines 54-Col. 42, line 27), instructions (e.g., Col. 41, lines 54-Col. 42, line 27), flags (see, e.g., Col. 92, lines 4 - 20, Col. 94, lines 28-47), etc. |
| inputting the digital data to the computer readable set of instructions; | See, e.g., generally Col. 92, lines 4 - 20, Col. 94, lines 28-47). See "internet surfing software" at Col. 94, lines 33-38. |
| detecting the title signal in the digital data: | E.g., detecting the universal code from the audio or video, e.g., Col. 41, lines 54-Col. 42, line 27. See also, e.g., Col. 94, lines 28-38. |
| comparing the title signal to the player signal; and | E.g., applying the daily password to the universal code. See, e.g., Col. 41, lines 54-Col. 42, line 27. |

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| performing an action based upon the comparison. | See, e.g., Col. 94, lines 28-38, see also Col. 27, lines 26-52, and Col. 41, lines 54-Col. 42, line 27. |
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(Of course, these tables are not meant to limit the scope of the claims, as many other examples and implementations will fall within the scope of the claims.)

Thus, we respectfully request that Tone be removed as a reference and claims 25, 30 and 43 be allowed.

We also reserve our right to show support for other claims not specifically mentioned at this time including claims 1 and 49.

Remaining Claims

We respectfully submit that the remaining claims also recite patentable combinations. Favorable reconsideration is requested.

Conclusion:

We respectfully request a Notice of Allowance. In the meantime, the Examiner is invited to contact the undersigned with any questions.

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Respectfully submitted,

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